

REMARKS

The Examiner has rejected the claims based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. Specifically, the claims have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of the co-pending applications cited by the Examiner. Such rejection has been overcome, in view of a terminal disclaimer submitted herewith.

The Examiner rejected Claims 1 and 9 under 35 U.S.C. 102(b) as being anticipated by Bellare et al. Such rejection is overcome, however, in view of the amendments made hereinabove. Specifically, the subject matter of various dependent claims has been added to such rejected claims.

The Examiner also rejected Claims 1-16 under 35 U.S.C. 102(a) as being anticipated by Balenson et al. Applicant respectfully submits that the Balenson reference is not prior art. To reject the claims, the Examiner has relied upon 35 U.S.C. 102(a). 35 U.S.C. 102(a) states:

"a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent." (emphasis added)

Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by applicant himself/herself or on his/her behalf. See MPEP 715.01(c).

Where the applicant is one of the co-authors of a publication cited against his or her application, ... the applicant may overcome the rejection by filing a specific affidavit or declaration under 37 CFR 1.132 establishing that the article is describing applicant's own work. An affidavit or declaration by applicant alone indicating that applicant is the sole inventor and that the others were merely working under his or her direction is sufficient to remove the publication as a reference under 35 U.S.C. 102(a). In re Katz, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). See MPEP 715.01(c).

Docket: NAI1P079/99.122.01

-6-

In fact, even if applicant's work was publicly disclosed prior to his or her application, applicant's own work may not be used against him or her unless there is a time bar under 35 U.S.C. 102(b). In re DeBaun, 687 F.2d 459, 214 USPQ 933 (CCPA 1982) (citing In re Katz, 687 F.2d 450, 215 USPQ 14 (CCPA 1982)). See MPEP 2136.05.

Moreover, an uncontradicted "unequivocal statement" from the applicant regarding the subject matter disclosed in an article or patent will be accepted as establishing inventorship. In re DeBaun, 214 USPQ 933, 936 (CCPA 1982). See MPEP 716.10.

Attached is an affidavit to this effect. In view of the above remarks and the attached affidavit, the Balenson reference is deemed removed as prior art.

All of the claims are thus deemed in condition for allowance.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P079/99.122.01).

Respectfully submitted,  
Silicon Valley IP Group, PC.

Kevin J. Zilka  
Registration No. 41,429

P.O. Box 721120  
San Jose, CA 95172-1120  
408-505-5100

Docket: NAI1P079/99.122.01

-7-